IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: :   Group Art Unit: 2171

                              :   Examiner: Rones, C..

Peter Y. Hsu et al.   :   Intellectual Property

Serial No: 09/190,554   :   Law Department - 4054

Filed: November 12, 1998   :   International Business

Title: BOOKMARKING OF WEB   :   Machines Corporation

PAGE FRAMES IN WORLD WIDE WEB :   11400 Burnet Road

FOR ACCESSING WEB PAGES   :   Austin, Texas 78758

WITHIN A FRAMES IMPLEMENTATION:

Date: ___8/18/03___   :

CERTIFICATE OF MAILING

I hereby certify that this correspondence including a Brief
on Appeal (in triplicate) is being deposited with the United
States Postal Service as first class mail in an envelope
addressed to: Commissioner for Patents, P.O. Box 1450
Alexandria, VA 22313-1450 on _August 18, 2003_ .

PATSY SPEARS
_____

Patsy Spears   08-18-2003
Signature   Date

TRANSMITTAL OF APPELLANTS' BRIEF UNDER 37 CFR 1.192(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

    Attached is Appellants' Brief (in triplicate) in this
Appeal from a decision of the Examiner dated March 18, 2003
finally rejecting Claims 1-21.

    Applicants respectfully request that the Appeal Brief
fee be waived by the U.S. Patent Office since Applicants
filed a previous Appeal herein on October 19, 2001, and a
subsequent Appeal Brief for which they already have paid the

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<u>Appeal and Appeal brief fees</u>. Subsequently, after
Applicants filed their Brief in this earlier Appeal, the
Examiner withdrew his previous final rejection, and reopened
the present prosecution.

Should there be any charge herein, please charge
Deposit Account 09-0447. A duplicate of this
notice is attached.

Respectfully submitted,

By _Leslie Van Leeuwen by J. B. Kraft_
Leslie Van Leeuwen
Registration No. 42,196
Intellectual Property Law

Docket No: AT9-98-340
Telephone No:
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IBM Corporation - 4054
11400 Burnet Road
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PATENT
09/19●54

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Technology Center 2100

BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal from the Final Rejection, dated March
18, 2003, of Claims 1-21 of this Application . An Appendix
containing a copy of each of the claims is attached.

I.   Real Party in Interest

The real party in interest is International Business
Machines Corporation, the assignee of the present
Application.

II.   Related Appeals and Interferences

None.

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III. Status of Claims

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

There are 21 claims in this Application.

B. STATUS OF ALL THE CLAIMS

1. Claims cancelled: None.
2. Claims withdrawn from consideration but not cancelled: None.
3. Claims pending: None.
4. Claims allowed: None.
5. Claims rejected: Claims 1-21.

C. CLAIMS ON APPEAL

Claims on appeal: Claims 1-21.

IV. Status of Amendment

Claims 1-21 were in the filed Application.

Claims 1 through 21 in this Application were first rejected in an Office Action mailed September 26, 2000.

Applicants filed a Response on December 19, 2000.

Claims 1-21 were again rejected in a Office Action mailed March 13, 2001.

Applicants filed an Amendment on June 8, 2001.

The claims were finally rejected in a first Final Rejection mailed July 26, 2001.

Applicants submitted a Response after Final Rejection filed August 30, 2001.

The Final Rejection of Claims 1-21 was maintained in an Advisory Office Action mailed October 23, 2001.

A Notice of Appeal initiating a first Appeal on this first Final Rejection of claims 1-21 was filed on October 19, 2001.

A Brief on this first Appeal was submitted on December 17, 2001.

The first Appeal Brief was deemed persuasive, the first Final Rejection was withdrawn on January 31, 2002, and a new rejection of claims 1-21 was made.

Applicants filed a Response to this new rejection on April 11, 2002.

Claims 1-21 were rejected in the second Final Rejection mailed June 4, 2002.

A Notice of Appeal initiating a second Appeal on this second Final Rejection of claims 1-21 was filed on September 4, 2002.

A second Brief on Appeal was filed on November 4, 2003.

The second Appeal Brief was deemed persuasive, the second Final Rejection was withdrawn on November 21, 2002, and a new rejection of claims 1-21 was made.

An interview was had with Examiner on January 14, 2003, and on January 17, 2003, a responsive amendment was filed which changed the claims to their present state.

Claims 1-21 were rejected in the third Final Rejection mailed March 18, 2003.

A third Notice of Appeal initiating a third Appeal on this third Final Rejection of claims 1-21 was filed on June 18, 2003.

The present third Brief on Appeal is being filed in this third Appeal

V. Summary of Invention

The present invention is directed the bookmarking of lengthy accessed Web documents of which only relatively small sections may be of interest to the user. Accordingly, the <u>invention provides the user with the option of either conventionally bookmarking the entire Web document received from a single remote location or defining sections of a lengthy Web document from a single remote location and individually bookmarking such defined sections to thereby treat such sections as independent bookmarked secondary documents.</u>

In understanding the present invention, we must remain focused on the primary purpose of the whole bookmarking art: to avoid storing at the local or receiving facility extensive or lengthy documents of interest. With a bookmark, all that need be stored at the local or receiving station is the bookmark link to the document which remains stored at the remote or source network station. Accordingly, the present invention provides the user with the means for defining sections of a lengthy Web document or page from a single location and for individually bookmarking such defined sections. This enables the user to be linked directly to the Web document area or section of interest to him without going through the process of bookmarking and thereby accessing the entire long Web document, and then going through the page until the area of interest is reached.

VI. Issues

Whether Claims 1-21 are unpatentable under 35 U.S.C. 102(e) as anticipated by <u>Appleman et al.</u> (U.S.5,918,010).

Whether claims 1-21 are obvious and thus patentable under 35 U.S.C. 103(a) over <u>Appleman et al.</u> (U.S.5,918,010).

VII. Grouping of Claims

All of the claims stand or fall together.

VIII. Argument

Claims 1-21 are not anticipated under 35 U.S.C. 102(e) by Appleman et al. (US5,918,010) and thus are patentable, and claims 1-21 are not obvious and thus patentable under 35 U.S.C. 103(a) over Appleman et al..

Rather than arguing these two issue individually, Applicants will establish that claims 1-21 are unobvious over Appleman, and thus, the claims would also be not anticipated by the reference. Appleman is directed to a problem which is almost the direct opposite of the problem which the present invention solves. This is clearly set forth at column 2, lines 20-31 (specifically cited by Examiner). Appleman's object is to form a composite Web document combining pages from multiple Web sites. However, conventional bookmarking presents a problem to him:

> "The use of bookmarks presents a problem for web pages as multiple coordinated, or framed, web pages. A bookmark is a reference to a single URL address........ When the user attempts to re-access the page with the bookmark, the browser display will load only one frame, which provides only part of the coordinated framed presentation of data."

Thus, unlike the problem addressed by the <u>present invention of how to reduce the size of a large Web document accessed and transmitted from a single location through a bookmark, Appleman's problem results from getting too little, i.e. only sections from multiple locations of his combined Web document, through a bookmark.</u> Appleman can not get the complete combined Web document through a bookmark.

Considering whether Appleman discloses or suggests the present invention, it is submitted that <u>Appleman does not disclose or suggest:</u>

A. the transmission from a single remote network
location to a receiving station of a document defining at
least one section in the document as an independent
secondary document; and

B. means at the receiving station for bookmarking the
defined secondary document to thereby circumvent accessing
the whole transmitted document.

The Examiner's Arguments.

For a disclosure of element A., the Examiner cites Fig.
7 in Appleman, and argues that frames 602 and 604 therein
are independent sections in a transmitted document.
Applicants submit that what is shown in Fig. 7. is not a
whole document with independent sections transmitted to a
Web receiving station. When read together with Fig. 6, col.
15, lines 34-67, it is clear that the two sections 602 and
604 shown in Fig. 7 are what is displayed at the receiving
Web site or station, and not what is in the transmitted Web
page. The display may be formed in two ways: either the
banner frame section 602 is already on the display when Web
page arrives at Web station (Yes to step 504, Fig. 6); or
section 602 is not on the display, then that section 602 is
built and added to the display (steps 512 and 514, Fig. 6,
as described at col. 15, lines 46-53). In neither case is
banner section 602 in the transmitted Web page from a single
location or source.

Consequently, since the transmitted page has no
independent section, there can be no independent section of
the transmitted page to bookmark.

**A Rejection based on anticipation under 35 U.S.C. 102, must
expressly or impliedly teach every element of invention
without modification.**
The Appleman patent clearly fails to meet this standard.
The only discussion which Appleman has relative to
bookmarking relates to problems which users have in

bookmarking as described above. Because of the problems that Appleman's system has with bookmarks, the patent dismisses the use of bookmarks to Web sites and instead makes use of human guides to maintain web sites specialized to areas of particular interest to the users. Appleman then combines the information from an appropriate set of such human guide maintained sites to be displayed within a template or framework which has the look and feel of a Web document. While bookmarking may be a source of Appleman's problems, Appleman's solution does not even involve bookmarking.

It is not seen how a patent with a limited but negative reference to bookmarks and then only as being inadequate can be considered as an anticipatory teaching under 35 U.S.C. 102. The present invention which provides the user with the option of either conventionally bookmarking the entire received transmitted Web document or individually bookmarking defined independent sections of the document and treating such sections as independent secondary bookmarked documents.

The Present Appeal Brief is the Third Appeal Brief Herein Necessitated by the Third Final Rejection

The third Final Rejection was required because the Examiner appeared to have recognized that for the reasons set forth above, Appleman could not support the rejection based upon anticipation under 35 U.S.C. 102. It is submitted that, as set forth above, the Appleman patent also fails to provide the basis for a rejection on obviousness under 35 U.S.C. 103.

In his concluding paragraph on Page 7 of the third and last Final rejection, the Examiner admits that Appleman does not disclose a document transmitted from a single remote location with a defined independent section whereby the either whole Web document or the independent section may be accessed through respective separate bookmarked URLs.
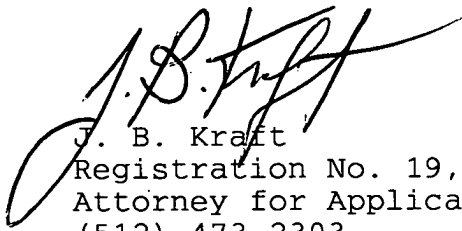
However, Examiner submits that it would be obvious to make such a modification in Appleman's teaching.

Applicants submit that they have established hereinabove that the teaching of Appleman would lead one skilled in the art away from even considering such a modification, since Appleman's own solution to his problems involves an alternative to bookmarking

IX. Conclusion

In view of the foregoing, Applicants submit that Claims 1-21 are not anticipated by Appleman et al. (U.S. 5,918,010), and thus are patentable under 35 U.S.C. 102(e). Accordingly, it is respectfully requested the Rejection be reversed, and Claims 1-21 be held to be patentable.

Respectfully submitted,

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APPENDIX

Claims on Appeal

1. In a computer managed communication network with user access via a plurality of data processor controlled interactive display stations and with a system for displaying documents transmitted to said display stations from locations remote from said stations, a system for bookmarking sections of said transmitted documents comprising:

  means associated with one of said receiving display stations for bookmarking selected transmitted documents to thereby store at said receiving display station, direct links to the documents at said remote locations for future access,

  means in a document transmitted from a single remote location for defining at least one section in the document as an independent secondary document, and

  means at said receiving display station for bookmarking said secondary document to thereby store at said receiving display station, a direct link to the secondary document at said single remote location, said link circumventing said transmitted document.

2. The system of claim 1 wherein said network is the World Wide Web.

3. The system of claim 2 wherein the transmitted documents are hypertext documents.

4. The system of claim 3 wherein the transmitted documents are Web pages in Hypertext Markup Language.

5. The system of claim 4 wherein said secondary document is defined by frames within a Web page and is also in Hypertext Markup Language.

6. The system of claim 5 further including:

means for displaying a list of said bookmarked documents, and

means for adding said secondary bookmarked documents to said list.

7. The system of claim 5 further including:

means for accessing and displaying said secondary documents via said direct link, and

means for maintaining connections between said secondary documents and said transmitted documents, whereby said transmitted documents may be accessed and displayed through said accessed secondary documents.

8. In a computer managed communication network with user access via a plurality of data processor controlled interactive display stations and with a system for displaying documents transmitted to said display stations from locations remote from said stations, a method for bookmarking sections of said transmitted documents comprising:

bookmarking at one of said receiving display stations selected transmitted documents to thereby store at said receiving display station, direct links to the documents at said remote locations for future access,

defining in a document transmitted from a single remote location at least one section as an independent secondary document, and

bookmarking said secondary document at said receiving display station to thereby store at said receiving display station, a direct link to the secondary document at said single remote location without accessing said transmitted document.

9. The method of claim 8 wherein said network is the World Wide Web.

10. The method of claim 9 wherein the transmitted documents are hypertext documents.

11. The method of claim 10 wherein the transmitted documents are Web pages in Hypertext Markup Language.

12. The method of Claim 11 wherein said secondary document is defined by frames within a Web page and is also in Hypertext Markup Language.

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13. The method of claim 12 further including the step of:

    displaying a list of said bookmarked documents, and

    adding said secondary bookmarked documents to said

list.

14. The method of claim 12 further including the steps of:

    accessing and displaying said secondary documents via

said direct link, and

    maintaining connections between said secondary

documents and said transmitted documents, whereby said

transmitted documents may be accessed and displayed through

said accessed secondary documents.

15. A computer program having code recorded on a computer

readable medium for bookmarking sections of transmitted

documents in a computer managed communication network with

user access via a plurality of data processor controlled

interactive display stations and with a system for

displaying documents transmitted to said display stations

from locations remote from said stations comprising:

    means for bookmarking selected transmitted documents to

thereby store at a receiving display station, direct links

to the documents at said remote locations for future access,

    means in a document transmitted from a single remote

location for defining at least one section in the document

as an independent secondary document, and

    means for bookmarking said secondary document to

thereby store at said receiving display station, a direct

link to the secondary document at said single remote

location without accessing said transmitted document.

16. The computer program of claim 15 wherein said network

is the World Wide Web.

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17.   The computer program of claim 16 wherein the transmitted documents are hypertext documents.

18.   The computer program of claim 17 wherein the transmitted documents are Web pages in Hypertext Markup Language.

19.   The computer program of claim 18 wherein said secondary document is defined by frames within a Web page and is also in Hypertext Markup Language.

20.   The computer program of claim 19 further including:
      means for displaying a list of said bookmarked documents, and
      means for adding said secondary bookmarked documents to said list.

21.   The computer program of claim 19 further including:
      means for accessing and displaying said secondary documents via said direct link, and
      means for maintaining connections between said secondary documents and said transmitted documents, whereby said transmitted documents may be accessed and displayed through said accessed secondary documents.